

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment**REMARKS**

In response to the Office Action dated March 23, 2005, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

The United States Patent and Trademark Office (the "Office") objected to the Abstract for excessive wording and for embedded hyperlinks. Claims 1, 4-5, 8-9, 12, 15-16, 17-20, 25-31, 38-39, and 41 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,732,366 to Russo. Claims 2-3, 21-22, and 35-37 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 5,262,875 to Mincer *et al.* Claims 6-7 and 10-11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 6,141,488 to Knudsen *et al.* Claims 13-14 and 43-52 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 5,883,677 to Hofmann. Claims 23-24, 32-34, 40, and 42 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo*. The Assignee shows, however, that the amended claims are neither anticipated nor obviated by the cited documents. The Assignee thus respectfully submits that the pending claims distinguish over the cited documents.

Discussion with Examiner and SPE

The Examiner, the SPE, and the attorney discussed this response. Examiner Lambrecht asked that "in bytes per second" be added to the claims to further distinguish from the cited documents. The SPE also suggested that one or more dependent claims emphasize a "storage position identifier," for he had not seen this in the field.

Objection to the Abstract

The United States Patent and Trademark Office (the "Office") objected to the Abstract for excessive wording. This amendment replaces the originally-filed Abstract with a version not exceeding 150 words. Examiner LAMBRECHT is thanked for noting this issue.

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment**Objection to "Hyperlinks"**

The Office Action also mentions an objectionable embedded hyperlink in the specification. The Attorney for the Assignee, however, could not find a hyperlink in the specification. The Assignee will thus assume this objection is erroneous. If the objection is correct, Examiner Lambrecht is asked to specifically point out the location of the hyperlink, using page and line numbers.

Rejection under 35 U.S.C. § 102

Claims 1, 4-5, 8-9, 12, 15-16, 17-20, 25-31, 38-39, and 41 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,732,366 to Russo. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the amended claims patentably distinguish over *Russo*. The reference to *Russo* does not anticipate the claims, so the Assignee respectfully requests that Examiner Lambrecht to remove the 35 U.S.C. § 102 (e) rejection.

The claims have been amended to incorporate features originally presented in claims 2 and 36. A multimedia content item is automatically received "at a transmission rate that is less than a real time transmission rate." Because this feature distinguishes over *Russo*, and because this feature was included in originally-presented in claims 2 and 36, Examiner Lambrecht has no cause for a final rejection in the next office action. Amended claim 1, for example, is reproduced below.

1. (Currently Amended) A system for multimedia on demand, the system comprising:

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment

a mass storage device, the mass storage device adapted to receive and store a multimedia content item;

a processor, the processor coupled to the mass storage device; and

a memory, the memory coupled to the processor, the memory storing a multimedia-on-demand data table and multimedia-on-demand instructions, the multimedia-on-demand data table including

a multimedia content identifier field to store a multimedia content identifier, the multimedia content identifier to correspond to a multimedia content item stored on the mass storage device, and

a multimedia content usage indicator field to store a multimedia content usage indicator, the multimedia content usage indicator associated with the multimedia content item stored on the mass storage device,

the multimedia-on-demand instructions to be executed by the processor, the multimedia-on-demand instructions including instructions to

automatically receive the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second, and

send a multimedia-on-demand usage message, the multimedia-on-demand usage message based at least in part on the multimedia content usage indicator.

Independent claims 17, 26, 38, and 41 have been amended to include similar features.

Russo does not anticipate the claims. *Russo* fails to teach or suggest "automatically receiv[ing] the multimedia content item at a transmission rate that is less than a real time transmission rate." Because *Russo* is silent to such features, the patent to *Russo* cannot anticipate the claims. The Assignee, then, respectfully requests that Examiner Lambrecht remove the § 102 rejection.

Rejection of Claims 2-3, 21-22, and 35-37 under 35 U.S.C. § 103 (a)

Claims 2-3, 21-22, and 35-37 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 5,262,875 to Mincer *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment

by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

First, claims 21, 22, and 35 have been cancelled, so the rejection is moot with respect to these claims.

Second, features from claims 2 and 36 have been incorporated into the independent claims. Claim 2, for example, has been incorporated into many of the independent claims. These amended, independent claims recite "*automatically receiv[ing] the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second.*" Claim 36 already recited "*the transmission rate being less than the playback rate of the multimedia content item.*"

The proposed combination of *Russo* and *Mincer* fails to teach or suggest such a transmission rate. Examiner Lambrecht is correct — *Mincer* describes transmitting audio-video program information "in less than real time." See, e.g., U.S. Patent 5,262,875 to Mincer *et al* (Nov. 16, 1993) at Abstract; at column 1, lines 58-59; column 2, line 15; column 3, line 10; column 4, line 55-56; column 7, lines 17-18; and column 9, line 3. A closer reading of *Mincer*, however, reveals that *Mincer* is describing the "time" for each transmission. Because *Mincer*'s "update network" (shown as reference numeral 50) can send data at higher rates than real time requirements, *Mincer*'s transceiver can receive the data at "less than real time." Claim 2, however, claims "*a transmission rate that is less than a real time transmission rate in bytes per second.*" Claim 36, likewise, recites "*the transmission rate being less than the playback rate of the multimedia content item in bytes per second.*"

Mincer provides an explanation. "Transceiver 10 is also operative for less-than-real-time reception of audio/video program information." *Id.* at column 4, lines 55-56. The update network 50 connects to the transceiver 10, and the "amount of compressed digital audio/video program information that is being transmitted and the speed at which update network 50 operates determines the total transmission time required." *Id.* at column 4, lines 59-63. "In the preferred

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment

embodiment of the present invention, update network 50 is substantially faster than the corresponding real-time data rate of the compressed digital audio/video program information, thus resulting in transmission times that are substantially less than the viewing time corresponding to the audio/video program information." *Id.* at column 4, line 66 through column 5, line 4 (emphasis added). *Mincer* then provides a mathematical example:

Current sample bit rates in the industry include a 1.2 Mbit/second rate for compressed digital audio/video program information (i.e., one second of viewing time corresponds to 1.2 Mbits of data) and a 12 Mbit/second data rate for update network 50. In this example, audio/video program information is received in one-tenth of real time. That is, a 30-second audio/video program is received in three second.

U.S. Patent 5,262,875 to *Mincer et al* (Nov. 16, 1993) at column 5, lines 5-12.

The proposed combination of *Russo* and *Mincer*, then, cannot obviate the claims. The patent to *Mincer* describes transmission times that are substantially less than real-time viewing times. The independent claims, however, recite transmission rates that are less than a real time transmission/playback rate. Because *Mincer* completely fails to realize that transmission rates can advantageously be less than a real time transmission/playback rate, one of ordinary skill in the art would not think the claims obvious in view of *Russo* and *Mincer*. The pending claims, then, cannot be obviated by the proposed combination of *Russo* and *Mincer*. Examiner Lambrecht is respectfully requested to remove the § 103 rejection.

Rejection of Claims 6-7 and 10-11 under 35 U.S.C. § 103 (a)

Claims 6-7 and 10-11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 6,141,488 to Knudsen *et al*. Claims 6, 7, 10, and 11, however, depend from independent claim 1 and, thus, incorporate the same distinguishing features. Claim 2, for example, has been incorporated into many of the independent claims. Claims 6-7 and 10-11, for example, incorporate "automatically receiv[ing] the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second." Because

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment

the proposed combination of *Russo* and *Knudsen* fails to teach or suggest such features, one of ordinary skill in the art would not think the claims obvious in view of *Russo* and *Knudsen*. Claims 6-7 and 10-11, then, cannot be obviated by the proposed combination of *Russo* and *Knudsen*. Examiner Lambrecht is respectfully requested to remove the § 103 rejection.

Rejection of Claims 13-14 under 35 U.S.C. § 103 (a)

Claims 13-14 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 5,883,677 to Hofmann. Claims 13-14, however, depend from independent claim 1 and, thus, incorporate the same distinguishing features of "*automatically receiv[ing] the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second.*" Because the proposed combination of *Russo* and *Hoffman* fails to teach or suggest such features, one of ordinary skill in the art would not think the claims obvious in view of *Russo* and *Hoffman*. Claims 13-14, then, cannot be obviated by the proposed combination of *Russo* and *Hoffman*. Examiner Lambrecht is respectfully requested to remove the § 103 rejection.

Rejection of Claims 43-52 under 35 U.S.C. § 103 (a)

Claims 43-52 were also rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 5,883,677 to Hofmann. The proposed combination of *Russo* and *Hoffman*, however, "teaches away" from these claims. "A prior art reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A prior art reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment

The Examiner's proposed combination changes the principle of operation of *Russo*. It's important to realize that *Hofmann* utilizes a specialized data bus called a "Consumer Electronics Bus." See, e.g., U.S. Patent 5,883,677 to Hofmann (Mar. 16, 1999) at column 3, lines 60-65. As *Hoffman* explains, "the CEBus 210 differs from most LANs in that its architecture provides for a control channel as well as data channels." *Id.* at column 4, lines 20-24. "Both the TPBus and CXBus are wideband media, and are able to support a large number of signals that have been spectrally multiplexed onto the medium." *Id.* at column 4, lines 25-27. "In order to accommodate the very wide spectrum needs of CATV, the CXBus uses two cables, labeled the external and internal cables (not shown)." *Id.* at column 4, line 65 through column 4, line 67. "CATV or TV antenna signals are placed on the external cable, while IHGS are placed on the internal cable." *Id.* at column 4, line 67 through column 5, line 2. "The IHGS signals are then carried by the internal cable to NODE 0 322 which is a 'headend'." *Id.* at column 5, lines 2-3.

Russo makes no provision for such a bus architecture. If *Russo* were modified, as Examiner LAMBRECHT proposes, to accept data from a plurality of sources, as shown by *Hofmann*, then *Russo's* principle of operation would have to be changed to utilize the CEBus architecture. *Russo's* principle of operation, for example, would have to be changed to utilize both control and data channels. *Russo* currently makes no provision for control and data channels. *Russo's* principle of operation would also have to be changed to support demultiplexing of signals — *Russo* currently does not show or describe a demultiplexer. *Russo's* principle of operation would also have to be changed to support two cables (the "internal" and "external" cables) required by the bus. If *Russo* were modified, as Examiner LAMBRECHT proposes, to accept data from a plurality of sources, then *Russo's* principle of operation must be changed to support all the requirements of *Hofmann's* CEBus architecture. This proposed architecture changes *Russo's* principle of operation and is impermissible. Examiner LAMBRECHT, then, is respectfully requested to remove the § 103 rejection.

Rejection of Claims 23-24, 32-34, 40, and 42 under 35 U.S.C. § 103 (a)

BS00343

U.S. Application No. 09/749,826 Art Unit 2631
Preliminary Amendment

Claims 23-24, 32-34, 40, and 42 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo*. Claims 23-24, however, depend from independent claim 17 and, thus, incorporate the same distinguishing features. Claims 32-34 depend from claim 26 and incorporate the same distinguishing features. Claim 40 depends from claim 38, and claim 42 depends from claim 1, and these claims incorporate the same distinguishing features. Because *Russo* fails to teach or suggest such features, one of ordinary skill in the art would not think the claims obvious in view of *Russo*. Examiner Lambrecht is respectfully requested to remove the § 103 rejection.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390

page 22

BEST AVAILABLE COPY